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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/680,260

10/08/2003

David William Abraham

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7590

05/19/2009

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EXAMINER

MAI, ANH D

ART UNIT

PAPER NUMBER

2814

MAIL DATE

DELIVERY MODE

05/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/680,260	Applicant(s) ABRAHAM ET AL.	
	Examiner Anh D. Mai	Art Unit 2814	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: See Final Rejection mailed February 9, 2009.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Anh D. Mai/
 Primary Examiner, Art Unit 2814

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant states: "the claim invention of exemplary claim 1 is directed to a method of patterning a magnetic fil. The method includes transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical transformation.... The portion of the magnetic thin film including NiFe and the transforming includes transforming the NiFe to a fluorine-containing film, and wherein the fluorine-containing film is electrically insulating.

The reference to Kamata '192 teaches exactly that. And yet, it has been explicitly discussed in the rejection that Kamata does not combine fluorine-based gas with "bromide-containing gas" in the reaction gas. Still, the main constituent of the transformation is provided by fluorine-containing gas. Kamata explicitly teaches "exposing an exposed portion of the surface of the ferromagnetic material layer in HALOGEN-CONTAINING active reaction gas ...to make the compound NONMAGNETIC or paramagnetic material. (paragraph [0030]).

However, Grider teaches a general term used in the art about "HALOGEN REACTION" gas to include fluorine, chlorine, iodine and bromide-containing gas or a combination thereof.

Once the Examiner has found evidence of prima facie case of obviousness, the burden has shifted to the Applicant to prove that the combination of fluorine and bromide-containing gas, or a combination thereof, would have made the invention of Kamata inoperable. The Applicant asserts, instead, that the term "or combination thereof" only exist in claim 17 of Grider. One should realize that, the claim is part of the disclosure as well.

Applicant further adds: "Thus, Grider does not provide any reason for introducing a combination of halogen species nor does Grider disclose or suggest any advantage that is achieved by introducing a combination of halogen chemistries".

Note that, it is exactly similar to the instant disclosure. The Applicant does not offer any advantage of adding bromide-containing gas in the active reaction gas but "bromide containing gas may be added to the fluorine-based gas".

The prima facie case of obviousness has been established. The rejection is maintained.

With respect to the reference to Ning and Chen, Applicant is only referring to Kamata and Grider but does not dispute the combinations with these references. The Rejection are maintained.